Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. CLARK

Appeal No. 2003-1552
Application No. 10/116,937

ON BRIEF

Before OWENS, TIMM, and DELMENDO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 21, 27-29, 32 and 33, and refusal to allow claims 24, 25, 30 and 31 as amended after final rejection. Claims 22, 23 and 26 have been allowed, and the rejections of claims 32 and 33 are withdrawn in the examiner's answer (page 3).

THE INVENTION

The appellant claims a fishing lure having air bubbles encapsulated in a solid plastic body. Claims 21 and 27 are illustrative:

21. A fishing lure body consisting essentially of soft, flexible, solid plastic having a plurality of air bubbles encapsulated therewithin, said encapsulated air bubbles occurring only at preselected locations that are spaced along a preselected length of said solid plastic body, and said solid plastic body being devoid of air bubbles except at said preselected spaced locations.

27. A fishing lure comprising a soft, flexible body of only solid plastic, a plurality of air bubbles encapsulated entirely within said solid plastic body, said air bubbles being encapsulated within said solid plastic body only at predetermined locations that are spaced along a longitudinal axis of said solid plastic body, and said solid plastic body being devoid of any randomly dispersed encapsulated air bubbles.

THE REFERENCES

Lindgard	4,732,766	Mar. 22, 1988
Kato	5,667,739	Sep. 16, 1997

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 102(b) as follows: claims 21, 24, 25, 27, 30 and 31 over Kato, and claims 27-31 over Lindgard.

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 21 and 27.

"Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference." *Corning Glass Works v. Sumitomo Electric*, 868 F.2d 1251, 1255-56, 9 USPQ2d 1962, 1965 (Fed. Cir. 1989).

Rejection over Kato

Claim 21

Kato discloses a fishing lure body (10) which can be made of plastic and has a large number of air bubbles sealed therein (col. 2, lines 63-67; col. 3, lines 5-8). The body has a cavity (12) to enhance its flexibility (col. 2, line 67 - col. 3, line 1).

The appellant's claim 21 requires a solid plastic body. The examiner argues that Kato's figure 2 shows a solid body wall containing encapsulated air bubbles, and that this solid body wall and the appellant's solid body, both of which contain air bubbles, are equally solid (answer, page 4).

The appellant's claim 21, however, does not require a solid body wall but, rather, requires a solid body. The relevant dictionary definition of "solid" is "not hollowed out" (reply brief, page 1). The appellant's specification does not indicate that the appellant gives the word "solid" a meaning which is inconsistent with this definition.

Kato's cavity-containing fishing lure body is not a solid body.[1] Hence, the examiner has not established that Kato anticipates the fishing lure body claimed in the appellant's claim 21. Accordingly, we reverse the rejection over Kato of claim 21 and dependent claims 24 and 25.

Claim 27

The appellant's claim 27, like claim 21, requires that the claimed fishing lure has a solid plastic body. As discussed above regarding the rejection of claim 21, the examiner has not established that Kato discloses this claim feature.

In addition, claim 27 requires that the solid plastic body is devoid of any randomly dispersed encapsulated air bubbles. Kato discloses making his fishing lure by 1) dipping a core metal (24) into a bath of paste-like coating material, which can be plastic and which contains air bubbles provided by a stirrer or tropical fish tank oxygen supply, such that air bubble-containing coating material adheres to the core metal,

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[1] In a disclosure not relied upon by the examiner, Kato states (col. 4, lines 31-36): "In the illustrated embodiment, the artificial bait main body **10** is formed by use of the above-mentioned core metal **24**. However, this is not limitative but other methods are also available. For example, the artificial bait main body can be formed by pouring a paste-like unformed material into a metal mold." Kato does not disclose a mold configured such that it produces a solid body, e.g., one not having a cavity portion, and is silent as to encapsulated air bubbles in the body.

2) solidifying the coating material, thereby entrapping the air bubbles, and then 3) removing the core metal to provide a fishing lure having, where the core metal used to be, a cavity portion (col. 3, lines 24-37; col. 4, lines 9-13 and 43-49). The entrapped air bubbles, therefore, appear to be randomly dispersed.

The examiner argues that the distribution of Kato's bubbles is not random because the stirrer or tropical fish tank oxygen supply used to form the bubbles is under the direct control of the maker of the lure body (answer, page 6). This argument is not well taken because the examiner has not established that any such direct control produces a non-random bubble distribution.

The examiner argues that Kato's teaching that "no air bubble is present in the outer peripheral portion thereof but air bubbles **14** are surely sealed in the artificial bait main body **10**" (col. 3, lines 19-21) "reinforces the idea that Kato is controlling the bubble distribution within the body" (answer, page 4). This argument is not convincing because the examiner has not established that the absence of air bubbles in the outer peripheral portion is the result of anything other than random bubble formation.

The examiner argues that "the act of dipping the core metal 24 of Kato into the unformed material 10A' with bubbles

therein is an act of preselecting and controlling the distribution of bubbles since the exact level at which the core metal 24 is dipped determines the ultimate bubble distribution along the lure body" (answer, pages 4-5). The depth to which the core metal is dipped determines the length of the bait, but the examiner has not provided evidence or reasoning which shows that the dipping depth determines the bubble distribution along that length.

The examiner argues that "having the lower end of the core metal 24 immersed in the material 10A' would occur at a longer duration since it is the first portion to enter the material 10A' and would thus have greater bubble formation than what occurs at the higher end of the core metal 24 during the dipping process and would also lend to the idea that the bubble formation is controlled" (answer, page 5). This argument is not persuasive because it is mere speculation.

For the above reasons we find that the examiner has not carried the burden of establishing a *prima facie* case of anticipation by Kato of the fishing lure claimed in the appellant's claim 27. We therefore reverse the rejection of this claim and dependent claims 28-30 over Kato.

Rejection over Lindgard

Lindgard discloses a fishing bait made by impregnating a resilient, nonwoven, long staple, multifilament polyester web, commercially available as insulation, with bread batter and then baking the batter to form bread (col. 2, lines 4-7; col. 4, lines 37-68). The "bait contains gas bubbles, as cavities, just as ordinary bread" (col. 2, lines 20-21).

The examiner argues that the appellant's "comprising" transition term does not exclude Lindgard's bread (answer, pages 7-8). Even if the appellant's claim 27 does not exclude bread, Lindgard's plastic fiber insulation web is not a solid plastic body and does not encapsulate the gas bubbles in the bread.

The examiner argues that "the bubbles of Lindgard are not randomly dispersed or the result of a random act, since they directly result from the method of making the bait performed by the user to place them within the bait in the first place so as to provide buoyancy to the bait" (answer page 8). Although Lindgard chose the method for forming the bubbles, i.e., baking bread batter, the chosen method forms bubbles which are randomly dispersed. Hence, the examiner's argument is incorrect.

For the above reasons we reverse the rejection over Lindgard.

DECISION

The rejections under 35 U.S.C. § 102(b) of claims 21, 24, 25, 27, 30 and 31 over Kato, and claims 27-31 over Lindgard, are reversed.

REVERSED

TERRY J. OWENS Administrative Patent Judge	)	
CATHERINE TIMM Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROMULO H. DELMENDO Administrative Patent Judge	)	

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CHARLES M. KAPLAN
Patent Attorney
30 N. Nanagosa Trail
Suttons Bay MI 49682